



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,032	01/19/2001	Gary L. Bennis	5437cp	7928

7590 05/19/2004

Carl L. Johnson  
Jacobson and Johnson  
Suite 285  
One West Water Street  
St. Paul, MO 55107-2080

EXAMINER

ROWAN, KURT C

ART UNIT	PAPER NUMBER
----------	--------------

3643

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/766,032

Applicant(s)

BENNIS, GARY L.

Examiner

Kurt Rowan

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb 6, 2004 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Kotis.

The patent to Kotis shows a fishing bobber having a main body 14 and a resiliently displaceable member 10, 15 with respect to the main body of the bobber in response to a force on member 10, 15 noting that the spring 10 is fixed on the line 11 at 10a as disclosed in column 1, lines 57-60.

4. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Ingram.

The patent to Ingram shows a two stage fishing bobber in Fig. 1 having a main body 10 and a member 12 resiliently displaceable with respect to the bobber main body to a force exerted on the member as disclosed in column 2, lines 20-30.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotis.

The patent to Kotis shows a fishing bobber as discussed above. Kotis forces down the member 10, 15 in response to a force on the line and then the main body will move downwardly as the spring is compressed. It is not clear if the force to displace the member to a down position is substantially equal to the buoyant force of the bobber main body, but it follows that when the member 10 is in the down position, that the bobber main body is submerged since the spring 10 is displaced downwardly, the spring will start to compress and move the main body downwardly. In reference to claims 19-20, it would have been obvious to employ a force to displace the member to a down position that is equal to the buoyant force of the main bobber body so that when the member is in the down position, the bobber main body is submerged since routine experimentation would be used to determine the amounts of force required to submerge the main bobber body and the resilient member.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram.

Art Unit: 3643

The patent to Ingram shows a two stage bobber as discussed above. In reference to claim 19, Ingram does not disclose that the force to displace the member to a down position is equal to the buoyant force of the bobber main body so that when the member is in the down position, the bobber main body is submerged. However, it would have been obvious to employ a main bobber body and a member that have substantially equal forces since routine experimentation would be used to determine the exact values of the force to displace the member to a down position and the buoyant force of the bobber main body.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram as applied to claim 18 above, and further in view of Behensky.

The patents to Ingram and Behensky show fishing bobbers. Ingram has been discussed above and does not show a spring. The patent to Behensky shows a bobber having a main body 1 and a resiliently displaceable member 10, 15 with a spring 16. In reference to claim 20, it would have been obvious to provide Ingram with a spring as shown by Behensky since merely one mechanical equivalent member is being substituted for another to hold the fishing line in the bobber main body.

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed Feb 6, 2004 is insufficient to overcome the rejection of claims 18-20 based upon Kotis as set forth in the last Office action because:

It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. Further, commercial success can not be used to overcome a rejection under 35 USC 102. Applicant has shown a large volume in sales, but this alone does not mean that the invention was successful in the market place solely due to its merits. The

Art Unit: 3643

declaration lacks any advertising expenditures (and the dollar amount of the 74,000 units) which could affect the amount of sales.

9. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321.

The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR